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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,928	01/11/2002	Ernst Rudolf F. Gesing	Mo-6884/LeA 33871	3956

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EXAMINER

MORRIS, PATRICIA L

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 06/19/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/030,928

Applicant(s)

Gesing et al

Examiner

PMorris

Group Art Unit

1625

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-8 and 10 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-8 and 10 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☒ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-4, 8 and 10 drawn to compounds of formula (I), compositions and use.

Group II, claim 5, drawn to multiple processes of preparing.

Group III, claim 6, drawn to compounds of formula (II).

Group IV, claim 7, drawn to compounds of formula (IV).

The inventions listed as Groups I- IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Groups I and II are related as process of making and product made. In the instant case, the products as claimed can be made by materially different processes as evidenced by applicants' own claims and specification.

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Groups I and III, IV are related as final products and intermediates. In the instant case, the intermediate compounds have different uses, *i.e.*, corrosion inhibitors, intermediates in polymer synthesis, photographic agents, antifogging agents, pharmaceuticals, etc.

Due to the numerous variables  $R^1$ ,  $R^3$ ,  $R^4$  etc., and their widely divergent meanings, a precise listing of inventive groups can not be made. Illustrative of different inventive concepts may be made by reference to the compounds in the Examples of the instant application and herbicidal compositions thereof) as for example:

the compounds of

I. Example 1

II. additional heterocycles are not exemplified, etc.,

With the election of a specific exemplified compound, a generic concept, including the corresponding composition and method of use, will be identified by the examiner as the inventive group for examination.

The claims herein lack unity of invention under PCT Rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The compounds claimed contain an thiophene group which does not define a contribution over the prior art. The substituents on the structure vary extensively and when taken as a whole result in vastly different compounds. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper.

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In the event of an election of either Groups I , III or IV, applicant is required to elect a specific compound. In the event of an election of Group I, applicant is also requested to elect one method of making the elected product.

37 CFR 1.475(b) an international or a national stage application containing claims drawn to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combination of categories:

- (1) A product and a process specifically adapted for the manufacture of said product;  
or
  - (2) A product and process of use of said product; or
  - (3) A product, a process specially adapted for the manufacture of the said product,  
and a use of the said product; or
  - (4) A process and an apparatus or means specifically designed for carrying out the  
said process; or
  - (5) A product, a process specifically adapted for the manufacture of the said product,  
and an apparatus or means specifically designed for carrying out the said process.
- (c) If an application contains claims to more or less than one of the combination of categories of inventions set forth in paragraph (b) of this section, unity of invention might not be present.

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(d) If multiple products, processes of manufacture, or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories relied thereto will be considered as the main invention in the claims.

(e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claim or as alternatives within a single claim.

Once applicant has elected a compound from Group I, he is permitted to have, in view of the fact that this application enters the national stage through 35 U.S.C. 371, no more than one process of preparing that elected product. See PCT Rule 13.2.

Also, note 1134 OG 197, where it is specifically recited that under PCT Rule 13.2(i), claims are permitted to one product, one process of manufacturing the product and one method of use.

Because these inventions lack unity of invention for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter restriction for examination purposes as indicated is proper

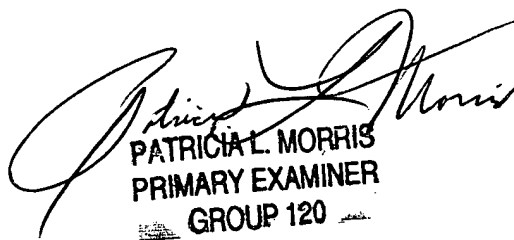
Applicant may file the divisional subject matter noted in divisional applications. If applicant wishes a generic expression of the elected invention the claims here need be amended to reflect that election.

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Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

This restriction requirement is being written as previous experience has indicated that with Foreign applicants and the inherent time delays, applicants' representative is better able to make an informed, correct, election of the invention applicants would wish to have prosecuted here if applicants are given the opportunity to see the restriction requirement laid out, and given the time to make an informed decision.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Morris whose telephone number is (703) 308-4533. The examiner can normally be reached Mondays through Fridays.

  
PATRICIA L. MORRIS  
PRIMARY EXAMINER  
GROUP 120

plm

June 13, 2002